

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Donald L. Nisley et al.

§ Group Art Unit: 3683

Serial No.: 09/938,793

§ Examiner: Torres, Melanie

Filed: August 24, 2001

§ Atty. Docket: DODG:0044/YOD/EUB
01RE025

For: SEALING SYSTEM FOR
BEARING ASSEMBLY

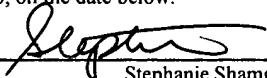
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Stephanie Shamgar

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In accordance with the Official Gazette Notice of July 12, 2005, Appellants respectfully submit this Pre-Appeal Brief Request for Review. This Request is being filed concurrently with a Notice of Appeal of the Examiner's improper rejection of claims 1-10 and 12-21 of the present application. For at least the reasons set forth in the Response filed December 13, 2005, and the reasons set forth below, Appellants respectfully submit that claims 1-10 and 12-21 are allowable in their present form. Appellants respectfully request reconsideration of the above-referenced application in view of the following remarks.

As an initial matter, Appellants respectfully, but vigorously, traverse the Examiner's refusal to enter the sole amendment submitted in the Response filed December 13, 2005, and the Examiner's contention that the amendment is a "newly added definition for the 'single-stage rotating seal' [that] is not supported by the original specification." Advisory Action mailed January 5, 2006, pg. 2, lines 1-2; *see* Response to Final Office Action filed December 13, 2005, pg. 2; *see*

also id. at page 8, lines 11-22. Particularly, the amendment was submitted to obviate an objection to the specification, in which the Examiner opined that the specification failed to provide antecedent basis for the recitation of a “single-stage seal” in the present claims. *See* Final Office Action mailed October 13, 2005, pg. 2, lines 1-5. Appellants noted that the original figures, including FIGS. 3 and 5, clearly illustrate a single-stage rotating seal formed by the cover 24 and the flinger 26, and that the specification describes the structure of the cover and the flinger in such detail that one skilled in the art would *immediately* appreciate the single-stage nature of the seal. However, in the interest of furthering prosecution, Appellants merely provided the amendment to the specification noted above to appease the Examiner. As any person of skill in the art would immediately appreciate that the recited seal illustrated in the present figures is a single-stage seal, Appellants respectfully submit that the amendment to the specification, which merely states that which would be readily apparent to one skilled in the art viewing the figures of the present application, cannot be in any way logically considered a “new definition” for a single-stage seal.

Further, Appellants note that the Final Office Action did not even allege that the inclusion of “a single-stage rotating seal” in the claims constituted new matter. If the Examiner had improperly believed that such a recitation was new matter, the Examiner had a duty to formulate a rejection of the relevant claims in the Final Office Action. Instead, the Examiner merely objected to the specification for allegedly failing to provide antecedent basis for these recitations and did not raise any issue of new matter until the present Advisory Action. As the Examiner waited until the Advisory Action to make this baseless assertion, it is unclear whether the Examiner somehow believes that the amendment to the specification *itself* is new matter or believes that the inclusion of “single-stage” in the claims is new matter, even though the recitation was clearly not considered new matter in the Final Office Action. Both assertions are clearly unsupportable for at least the reasons provided above. Further, Appellants respectfully note that, if the Examiner intended to reject the claims based on allegedly new matter, the Examiner should have provided such a new rejection of the claims in an Office Action, not an Advisory Action. Appellants also respectfully remind the Examiner that the figures can serve to

provide the necessary disclosure and written description of the claimed subject matter. Consequently, any rejection or objection based on “new matter” with respect to the illustrated and recited single-stage seal is untenable.

Rejections Under 35 U.S.C. §§ 102 and 103

In the Office Action, the Examiner rejected claims 1-4, 7, 12-17, and 21 under 35 U.S.C. § 102(b) as anticipated by Grzina. The Examiner also rejected claims 1-4, 7, 12-17, and 21 under 35 U.S.C. § 103(a) as unpatentable over Grzina in view of Hatch et al. Additionally, the Examiner also rejected dependent claims 5, 6, 8-10, and 18-21 as unpatentable over Grzina in view of various secondary references. Appellants respectfully traverse these rejections.

The Grzina reference fails to disclose a rotatable flinger configured to form a single-stage seal.

Turning now to the present claims, the Grzina reference fails to disclose each element of independent claims 1 and 13. For instance, independent claim 1 recites “a rotatable flinger secured to the cover ... and configured to form a *single-stage rotating seal*” (emphasis added). Similarly, independent claim 13 recites “a rotatable member securable to the cover ... [and] configured to form a *single-stage rotating seal*” (emphasis added). Because the Grzina reference fails to disclose such elements, the cited reference fails to anticipate independent claims 1 and 13. Appellants respectfully direct the panel’s attention to the previous Response for a full explanation of the deficiencies of the Grzina reference. *See* Response to Final Office Action filed December 11, 2005, pg. 9, line 1 – pg. 11, line 10. In summary, however, the Grzina reference teaches a shaft collar (not numbered) that is configured to cooperate with end cover 6 to form a *three-stage* seal assembly. Consequently, this shaft collar cannot be reasonably compared to the recited flinger or rotatable member configured to form a *single-stage* seal.

In the Advisory Action, the Examiner points to the use of the word “comprising” in the preamble in support of the erroneous assertion that the Grzina shaft collar can be interpreted as a “single-stage rotating seal” because it includes at least one stage. Advisory Action, pg. 2, lines 3-

6. The Examiner's reliance on this transition word is grossly misplaced. For illustrative purposes only, Appellants respectfully request the panel to consider the difference between a bicycle and a unicycle. Obviously, a bicycle has two wheels, whereas a unicycle has only one. It is true, of course, that each of these vehicles could be aptly described as a vehicle having a wheel, or at least one wheel. However, no reasonable person would attempt to suggest that a bicycle is a unicycle simply because it includes a wheel. Similarly, cars, trucks, airplanes, and the like also have more than one wheel but cannot be reasonably considered a unicycle or single-wheeled vehicle. For this reason, it is evident that a recitation of "a vehicle having a wheel" is qualitatively different than "a single-wheeled vehicle." Similarly, and turning back to the issue at hand, claims 1 and 13 clearly recite "a single-stage rotating seal." Importantly, these claims *do not* recite "a rotating seal having at least a single stage," which is, unfortunately, the improper claim construction the Examiner is relying on in the present rejection. While the shaft collar of the Grzina reference is clearly configured to provide three sealing stages, and could be accurately described as a collar configured to provide at least one sealing stage, it is equally clear that the Grzina shaft collar is not configured to form a *single-stage seal*, as recited in the present claims. For at least these reasons, Appellants respectfully submit that the Grzina reference fails to disclose each and every element of independent claims 1 and 13.

The Hatch et al. reference also fails to disclose a rotatable flinger configured to form a single-stage seal.

Appellants respectfully note that the Grzina and Hatch et al. references collectively fail to disclose each element of independent claims 1 and 13. Appellants respectfully direct the panel's attention to the previous Response for a full explanation of the deficiencies of the Hatch et al. reference. *See* Response to Final Office Action filed December 11, 2005, pg. 12, line 5 – pg. 13, line 22. In short, as also noted above, the Grzina reference teaches a shaft collar that is configured to form a *multi-stage* seal assembly, not a *single-stage* rotating seal. The Hatch et al. reference also teaches a multi-stage seal and, thus, does not obviate the clear deficiencies of the Grzina reference. In fact, the Hatch et al. reference *explicitly states* that the seal disclosed in the reference is a "two-stage seal." As is evident from the discussion above, a two-stage seal cannot

be logically considered a single-stage seal. Because neither the Hatch et al. nor Grzina reference discloses a rotatable member configured to form a *single-stage* seal, the cited references cannot support a *prima facie* case of obviousness with respect to independent claims 1 and 13.

Appellants note that each of claims 5, 6, 8-10, and 18-21 depends from one of independent claims 1 and 13. The secondary references fail to obviate the deficiencies of the Grzina and Hatch et al. references and, therefore, these claims are believed allowable based on their dependency from a respective allowable independent claim, as well as for the subject matter separately recited by these claims.

For these reasons, among others, Appellants respectfully request withdrawal of the rejections under 35 U.S.C. § 102 and 103 and allowance of claims 1-10 and 12-21.

In view of the remarks set forth above, Appellants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: January 13, 2006

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